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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/886,881	07/02/1997	JOHN P. ECKSTEIN	PA1220-C2	9371

EXAMINER
TARAZANO, DONALD LAWRENCE

ART UNIT	PAPER NUMBER
1773	

7590 12/22/2003  
MCDERMOTT WILL & EMERY  
227 W MONROE STREET  
CHICAGO, IL 60606

DATE MAILED: 12/22/2003

# Office Action Summary

Application No.

08/886,881

Applicant(s)

ECKSTEIN ET AL.

Examiner

D. Lawrence Tarazano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 10-17-2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 109-115 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 109-115 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 33.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 109-115 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 32-39 of U.S. Patent No. 6,437,064 in view of (Mehta et al. (5,358,792) or Hodgson, Jr. (5,206,075) and in view of Newsome (4,457,960).

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the issued patent and the instant application are directed to structures, which comprise a barrier layer and at least one layer made from a polymer made by a single-site catalyst.

3. While the claims in the instant application do not require that the film be heat-shrinkable, instant claims do not preclude heat shrinkable structures; furthermore, Hodgson, Jr. (column 7, lines 35+) and Mehta et al. (Example IX) each teach that oriented multilayer films comprising polymers made by single site catalysis may be produced. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have oriented the films claimed in the instant application so that they would be useful in applications where shrinkable films would be used.

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4. 2 and 4 layer structures are claimed in the instant application and a five-layer structure is claimed in the allowed patent. However, the two structures are obvious variants of each other. Newsome shows how a conventional structure comprises a barrier surrounded by adhesive layers, two, which are, bound two surface layers. Since adhesion may be a problem, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have included adhesive layers in the claimed structures. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used two surface layers in the claimed structures comprising single sites catalyzed polymers so that both sides of the barrier layer could be protected from moisture and abrasion by coverings. For these reasons, the five-layer structure claimed in the allowed patent is an obvious variation of the structures claimed here.

#### *Response to Arguments*

1. Applicant's arguments filed 10-17-03 have been fully considered but they are not persuasive. The examiner is not convinced by the applicants' arguments. The instant claims are directed a multilayer film comprising a barrier layer and a layer comprising a blend of LDPE and a single site catalyzed polymer. The examiner asks applicants to review claim 39 in the allowed patent (6,437,064), which is directed to such a blend in combination with a barrier layer. The essential difference between the two sets of claims is the number of additional layers present, the specific barrier material, and the recitation that the films are heat shrinkable.

2. In the instant application, the applicants claim a number of barrier materials; this met by claim 36 of the allowed patent.

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3. While the allowed patent teaches heat shrinkable materials, the instant claims do not preclude heat shrinkable materials, and the examiner has cited prior art ((Mehta et al. (5,358,792) or Hodgson, Jr. (5,206,075) to show that films comprising single site catalyzed materials can be oriented to make heat shrinkable packaging films.

4. While there are different numbers of layers in the allowed patent and the instant claim, the examiner maintains that these additional layers would have been obvious to one having ordinary skill in the art. This is shown by Newsome (4,457,960); who also shows that the order of the layers can be changed.

5. One cannot practice claim 109 of the instant application with out infringing on the structures claimed in 6,437,064. The purpose of the secondary references is to show the state of the art and to show why modifications to the claimed articles in the application and the allowed patent would have been obvious. It is clear to the examiner that the allowed patent and the copending application cannot support separate patents.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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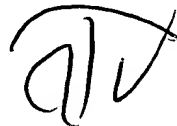
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Lawrence Tarazano whose telephone number is (703)-308-2379. The examiner can normally be reached on 8:30 to 6:00 (off every other Friday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on (703)-309-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0661.

D. Lawrence Tarazano  
Primary Examiner  
Art Unit 1773

A handwritten signature in black ink, appearing to be 'DLT' with a stylized flourish at the end.

dlt  
December 17, 2003